REMARKS

By this amendment, claim 1 has been amended. Claims 1-14 remain in the application. This application has been carefully considered in connection with the Examiner's Action. Reconsideration, withdrawal of the final action, and allowance of the application, as amended, are respectfully requested.

In the specification of the above-identified application, at least on page 2, lines 4-13; and on page 8, lines 20-32, the applicant provides a discussion of a device including a transmissive LCD display panel and back-lighting means. The present claimed invention is distinguished over such devices including transmissive LCD display panels, as discussed in the specification and as claimed, and further as re-discussed herein. Claim 1 has been further amended herein to more clearly point out and distinctly claim that which the applicant believes patentable over the cited art. Support for the amendment to claim 1 can be found in the specification on page 10, lines 8-9.

Advantages provided by the present claimed invention are discussed in the specification at least on page 3, lines 1-6; page 7, lines 31-33; and page 8, lines 1-2.

Rejection under 35 U.S.C. § 103

Claim 1

Claim 1 recites an image-sensing display device comprising: an image display part including a reflective image display panel and a front-lighting means, the front-lighting means for illuminating the reflective display panel during a display mode of the image-sensing display device, the front-lighting means including a transparent light guiding plate, the light guiding plate having a lower main flat surface, an upper main flat surface that is substantially parallel to the lower main flat surface, and side surfaces, the front-lighting means further including at least one light source arranged opposite an entrance face corresponding to at least one of the side surfaces, and a side face opposite the entrance face that is made reflective, the light guiding plate further having scattering elements, wherein light rays from the at least one source enter the light

guiding plate via the at least one of the side surfaces and are totally internally reflected until reaching a scattering element, the scattering element reflecting light incident thereon in different directions, wherein a portion of the reflected light passes through the lower main flat surface and propagates to the reflective display panel and wherein a remaining portion of the reflected light propagates through the light guiding plate, wherein further substantially all the light that enters the light guiding plate via the at least one of the side surfaces is coupled out of the light guiding plate and directed towards the reflective display panel; and an image-sensing part arranged on top of the reflective display panel of the image display part, the image-sensing part for capturing at least one image during a camera mode of the image-sensing display device, the image-sensing part including a two-dimensional array of photosensitive elements, wherein the front-lighting means of the image display part is arranged in front of the array of photosensitive elements on top of the reflective display panel and wherein the photosensitive elements of the image-sensing part and the reflective display panel and front-lighting means of the image display part are integrated in one module.

Claims 1-13 were rejected under 35 U.S.C. § 103 as being unpatentable over Rostoker (U.S. Patent No. 5,977,535) in view Umemoto (U.S. Patent No. 6,196,692 B1). Applicant traverses this rejection on the grounds that these references are clearly defective in establishing a prima facie case of obviousness with respect to claim 1.

As the PTO recognizes in MPEP § 2142:

> *... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

It is submitted that, in the present case, the examiner has not factually supported a prima facie case of obviousness for at least the following, mutually exclusive, reasons.

1. Even When Combined, the References Do Not Teach the Claimed Subject Matter

The Rostoker and Umemoto patents cannot be applied to reject claim 1 under 35 U.S.C. § 103 which provides that:

> *A patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains* ... (Emphasis added)

Thus, when evaluating a claim for determining obviousness, **all** limitations of the claim **must be** evaluated. However, since neither Rostoker nor Umemoto teaches an image-sensing display device with a front-lighting means that comprises a transparent *light guiding plate* where the upper main flat surface is substantially ***parallel*** to the lower main flat surface, **and** a *side face* opposite the entrance side face that is made ***reflective***, as is claimed in claim 1, it is impossible to render the subject matter of claim 1 as a whole obvious, and the explicit terms of the statute cannot be met.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

2. Prior Art That Teaches Away From the Claimed Invention Cannot be Used to Establish Obviousness

In the present case, the Rostoker reference provides back-lighting means to augment a visibility of an image on the LCD panel, and thus, is directed to a system in which the LCD panel is transmissive. As indicated above, the claimed embodiment of the present application is directed towards a reflective display panel with a front-lighting means that comprises a transparent *light guiding plate* where the upper main flat surface is substantially ***parallel*** to the lower main flat surface, **and** a *side face* of the

transparent light guiding plate opposite the entrance side face that is made ***reflective***, and which is distinguished from the transmissive display panel and the back-lighting means of Rostoker. In addition, as noted by the Examiner, "Rostoker discloses alternate embodiments but does not explicitly disclose a reflective display panel wherein the lighting means are front-lighting means which are arranged in front of the array of photosensitive elements on top of the reflective display panel." Thus, the system of Rostoker clearly teaches away from the reflective display panel of claim 1, recited above.

Since it is well recognized that teaching away from the claimed invention is a *per se* demonstration of lack of *prima facie* obviousness, it is clear that the examiner has not borne the initial burden of factually supporting any *prima facie* conclusion of obviousness.

Thus, for this reason alone, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

3. The references are not properly combinable if their intended function is destroyed

It is clear that the Rostaker and Umemoto patents are not properly combinable since, if combined, their intended function is destroyed. More particularly, if the Rostaker patent were modified with the surface light source device of Umemoto, as required by the rejection, it would be rendered inoperable for its intended purpose because the transmissive LCD panel would not reflect light, and a visibility of an image on the LCD panel would be diminished instead of augmented. As indicated herein above, Rostaker teaches a transmissive display panel, which teaches away from a reflective display panel, and furthermore, in particular, teaches that the transmissive display panel requires back-lighting. Still further, if the Rostaker patent were modified with the surface light source device of Umemoto, as required by the rejection, it would

interfere with and adversely impede the image capture function of the device of Rostaker. Furthermore, Umemoto does not teach or suggest converting a transmissive display into a reflective display. Moreover, to merely substitute a reflective display for the transmissive display of Rostaker would render the same inoperable for its intended purpose.

Thus, since this modification of the Rostaker patent clearly destroys the purpose or function of the invention disclosed in the Rostaker patent, one of ordinary skill in the art would not have found a reason to make the claimed modification.

Thus, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

4. The Combination of References is Improper

Assuming, arguendo, that none of the above arguments for non-obviousness apply (which is clearly not the case based on the above), there is still another, mutually exclusive, and compelling reason why the Rostoker and Umemoto patents cannot be applied to reject claim 1 under 35 U.S.C. § 103.

§ 2142 of the MPEP also provides:

> *...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made.....The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole'.*

Here, neither Rostoker and Umemoto teaches, or even suggests, the desirability of the combination since neither teaches the specific arrangement and location of the reflective display panel, array of photosensitive elements, front-lighting means, the transparent light guiding plate, at least one light source arranged opposite an entrance face, a side face opposite the entrance face being made reflective, as specified above and as claimed in claim 1.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In this context, the MPEP further provides at § 2143.01:

> *The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.*

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In addition to the above, it is noted that the Rostoker patent is based upon a patent originally filed in September 1992. It is also noted that the Umemoto patent was based on an application filed in April 1999. In the remarks portion of the office action, the Examiner indicates: "It is respectfully pointed out that Rostoker discloses an image sensing display device comprising an LCD display, and Umemoto teaches the reason, suggestion, and motivations to modify the device of Rostoker to further comprise a reflective display with front light guide, per rejections above, thereby eliminating the transmissive and back-lighted structure of Rostoker which would result in an operable structure per Applicant's enabling disclosure." (Emphasis added) However, Umemoto does not teach or suggest any image capture or camera operation mode, nor does Umemoto teach or suggest any array of photosensitive elements for use in any image capture or camera operation mode.

Accordingly, for at least the reasons stated herein, claim 1 recites an image-sensing display device that is clearly patentably distinct over the art of record. Moreover, claim 1 recites an image-sensing display that is not an obvious general modification of a transmissive display device, with or without an image-sensing part, to

be reflective and front-lighted.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Dependent claims 2-13 depend from and further limit, in a patentable sense, allowable independent claim 1 and therefore are allowable as well.

Claim 14 was rejected under 35 U.S.C. § 103 as being unpatentable over Rostoker in view Umemoto as applied to claims 1-13 above, and further in view of Konuma et al (Konuma) U.S. Patent No. 6,628,263 B1. Applicant traverses this rejection for at least the following reason. Claim 14 depends from and further limits, in a patentable sense, allowable independent claim 1. Accordingly, claim 14 is allowable.

In connection with a statement in the office action indicating that "Applicant has not argued examiner's positions/rejections of dependent claims 2-13. Therefore Applicant has acquiesced Examiner's positions/rejections as to claims 2-13." Applicants respectfully disagree with such a position. On the contrary, Applicant's note that claims 2-13 depend from and further limit, in a patentable sense, allowable base claim. Accordingly, no further discussion is believed necessary.

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Conclusion

It is clear from all of the foregoing that independent claim 1 is in condition for allowance. Dependent claims 2-14 depend from and further limit independent claim 1 and therefore are allowable as well.

The amendments herein are fully supported by the original specification and drawings; therefore, no new matter is introduced.

Withdrawal of the final action and an early formal notice of allowance of claims 1-14 is requested.

Respectfully submitted,

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